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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/030,519

06/05/2002

Burrhus Lang

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02/07/2011

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EXAMINER

BOCKELMAN, MARK

ART UNIT

PAPER NUMBER

3766

NOTIFICATION DATE

DELIVERY MODE

02/07/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/030,519	<b>Applicant(s)</b> LANG ET AL.	
	<b>Examiner</b> Mark W. Bockelman	<b>Art Unit</b> 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Appeal Brief Filed***

The examiner has discovered new art pertinent to applicant's claims that needs considering before proceeding to appeal. The following rejections based upon the newly discovered Swanson et al. USPN 5,111,812 reference are applicable as follows.

1. In view of the Appeal Brief filed on 9-27-2010, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below (MPEP 1207.04).

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Carl H. Layno/

Supervisory Patent Examiner, Art Unit 3766

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 37-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 37-52 use a negative intended use limitation that renders the claim indefinite. How an element is to be used involves future knowledge of the use of the device by the user which makes the claim indefinite. How a device will not be used makes the claim even more so indefinite since it requires the future knowledge of everyone.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37, 39-47, 49, 52-56 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Swanson USPN 5,111,812 or alone or alternatively in view of Canadian patent 1,219,642

Claims 37, 39-47, 49, 53-56 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Swanson. With regard to the disclosure of figure 5 of Swanson, conductive rings with contacts inherently thereon, whether they are welds or other attachment means, they are connecting elements. Ring member 18 is left unconnected

for purposes of current distribution. The device is used for delivering defibrillation therapy. While Swanson does not show particular connecting means such as tab elements for providing a weld surface would have been obvious. Canadian patent 1,219,642 is cited as but one reference that shows alternative connecting elements in the form of tabs. To have provided tabs to the Swanson device with tabs or other equivalents would have been notoriously old and well known electrical connection alternatives.

Claims 37-52 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Canadian patent 1,219,642 alone, or alternatively, in view of Swanson et al USPN 5,111,812.

Canadian patent 1,218,642, shows several embodiments of electrode configurations. In figure 3, 3 potential electrode elements 30, 33, 36 are shown that extend to a tab 32 with three uncontacted elements. The elements are each capable of being contactable by an electrode or can be consider "free" of a contacting element depending upon the intended use. Applicant's circular rings as shown in their drawings are all capable of being contacted by an electrical energy applicator. Thus, the examiner designates which elements are contactable in terms of intended use in interpreting applicant's claims. In claims 16-21, 23-28, 30 and 32 the examiner considers the contactable conductor to be electrode 30 and the uncontacted conductor to either elements 33 and/or 36. Regarding claims 22, the examiner considers the inner uncontacted conductor 33 to extend into the space between contactable conductors 30

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and 36. Regarding claim 31, the examiner considers the conductors to be formed in alternative (interleaved) surfaces (figure 4) wherein starting with the most inner conductor, every other conductor is contactable and the others are uncontacted.

Alternatively, Swanson et al. USPN 5,111,812 particularly teaches the use of an outer unconnected ring, with no electrical connections members thereon, To improve current distribution. To have provided such an outer ring member on the Ca. '642 patent to improve current distribution, an issue of which the Canadian patent is concerned with, would have been obvious in view of Swanson et al.

Claims 37-39, 41, 52 are rejected under 35 U.S.C. 102(b) as being anticipated by King USPN 4,282,886.

King shows an electrode 14 with a contactable surface that engages tab 14a. A piece of conductive foil 16a surrounds the electrode. The device would inherently include circuitry for heat applications.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38, 48, 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson et al USPN 5,111,812 in view of Canadian patent 1,219,642. To have provided connecting tabs or used hook shaped conductors for the electrodes would have been obvious in view of Ca. '642

Claim 53-56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canadian patent 1,219,642 alone or in view of Swanson et al. USPN 5,111,812.

Concerning claim 56, the claim reads upon the intermediate configuration of hooking up the electrode to the device of use wherein one contact is connected and the other not. This is not regarded as patentable subject matter over the Canadian patent. Alternatively, to have placed an outer unconnected conductive ring on the outer perimeter to improve current distribution for Swanson would have been obvious.

Concerning claims 53-55, To have used the Canadian patent in a bipolar configuration or a monopolar configuration wherein only the central electrode is used would have been obvious. Alternatively, to have placed an outer unconnected conductive ring on the outer perimeter to improve current distribution for Swanson et al. would have been obvious.

Claims 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over King USPN 4,282,886. To have placed the King electrode against the tissue to test the functioning of the device prior to removing the outer conductor for permanent attachment would have been an obvious procedure.

### ***Response to Arguments***

Applicant's arguments filed 9-27-2010 have been fully considered but they are not persuasive. Applicant's arguments are the same as they have been. Applicant wants to claim his invention using negative intended use clauses. Moreover, the claims use comprising language, thus the claims allow for the ring portion of the conductors of the Canadian patent to be the current equalizing surface, free of contacts, while the extending tab is considered a separate element. Moreover, the addition of the Swanson et al. reference which shows Applicant's structure for Applicant's purpose in Applicant's field of art further renders such modifications to Ca '632 obvious.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W. Bockelman whose telephone number is (571) 272-4941. The examiner can normally be reached on Monday - Friday 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Layno can be reached on (571) 272 -4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark W Bockelman/  
Primary Examiner, Art Unit 3766